

### **REMARKS**

Claims 1-23 are pending and under examination in the above-identified application. Claim 1 has been amended above. Support for the amendment can be found throughout the application including, for example, at pages 45-46. The claims have additionally been amended to correct various informalities. Accordingly, the amendments do not raise an issue of new matter and entry thereof is respectfully requested. Applicant has reviewed the rejections set forth in the Office Action mailed August 26, 2003, and respectfully traverses all grounds for the reasons that follow.

Applicant would like to thank Examiners Forman and Lu for extending a personal interview with Applicant's representatives on January 20, 2004. As recorded in the Interview Summary, the rejection under 35 U.S.C. § 102(e) was discussed. The amendments above and remarks below are believed by Applicant to substantially conform to the subject matter discussed in the interview and result in the Examiner's reconsideration of the rejection.

Claims 1, 2, 12, 13 and 16 stand objected to allegedly because of informalities. Applicant has amended these claims according to the Examiner's suggestions. Accordingly, Applicant respectfully requests withdrawal of these objections.

### **Rejections Under 35 U.S.C. § 112**

Claims 12-15 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for use of the term "flanking" in connection with first and second target sequences. In this regard, the Office asserts that it is unclear whether the first target sequence or the second target sequence is part of the target nucleic acid and clarification is requested.

Applicant contends that the claim as written is clear and definite. Claim 12 recites that the ligation primers hybridize to a target nucleic acid. The primers bind to a sequence within the target nucleic acid that flanks a target sequence. Accordingly, by the language of the claim the target nucleic acid corresponds to a nucleic acid molecule and the

ligation primers bind to a sequence within that nucleic acid molecule. In step (b) the first ligation primers hybridize to the target nucleic acid in a region that flanks the target sequence of that target nucleic acid. Similarly, in step (f) the second ligation primers hybridize to the target nucleic acid to a region that flanks a second target sequence of that target nucleic acid. Accordingly, claim 12 is sufficiently clear to distinctly claim the invention and can include one or more target sequences within a target nucleic acid. Therefore, Applicant respectfully requests withdrawal of this ground of rejection.

### **Rejections Under 35 U.S.C. § 102**

Claims 1-3, 8-12, 16 and 18-20 stand rejected under 35 U.S.C. § 102 (e) as anticipated by Chee et al., U.S. Patent No. 6,355,431. Chee et al. is asserted to have a common inventor with the above-identified application and an earlier priority date. Chee et al. is alleged to describe a composition of first primers immobilized to a solid support and a target nucleic acid, ligation of primers, removal of unligated primers and further repeating these steps.

For similar reasons, claims 1, 2, 4-10, 12, 13, 15, 16 and 18-20 also stand rejected under 35 U.S.C. § 102 (e) as anticipated by Chee et al., U.S. Patent No. 6,355,431. In this regard, Chee et al. is alleged to additionally describe the use of an enzyme to extend a first primer to form a newly synthesized RNA strand.

Applicant contends that the claims as filed are distinct from Chee et al. However, to further prosecution of the above-identified application, independent claims 1, 12 and 16 have been amended to particularly recite a second analysis and to recite that reuse of a target nucleic acid can be performed without substantial loss in signal. Accordingly, this amendment renders the rejection moot and Applicant respectfully requests its withdrawal.

### **Rejections Under 35 U.S.C. § 103**

Claims 17 and 21-23 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over Chee et al. The patent to Chee et al. and above-identified application are both assigned to

Illumina, Inc. At the time the latter invention was made, it was subject to an obligation to assign, and owned by Illumina, Inc. Accordingly, Chee et al. does not constitute a proper reference under 35 U.S.C. § 103 and withdrawal is respectfully requested.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as allegedly obvious over Chee et al., in view of Barany et al. In this regard, the Office asserts that dependent claim 14, directed to DNA polymerase amplification using dNTPs, is obvious from the substitution of one polymerase with another polymerase because they have known properties.

Applicant contends that the claim as filed is unobvious over the combination of Chee et al. and Barany et al. However, to further prosecution of the above-identified application, claim 12 has been amended to particularly recite that the second use of a target nucleic acid can be performed without substantial loss in signal. Accordingly, this amendment renders the rejection moot and Applicant respectfully requests its withdrawal.

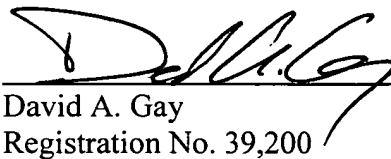
Inventor: Stuelpnagel et al.  
Serial No.: 09/931,285  
Page 12

**CONCLUSION**

In light of the Amendments and Remarks herein, Applicant submits that the claims are in condition for allowance and respectfully request a notice to this effect. Should the Examiner have any questions, he is invited to call the undersigned attorney.

Respectfully submitted,

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